REMARKS

Claims 1, 2, 10, 11, 17, 18, 20, 21, 27, 28, 34, 35, 41, 42, 44, 45, 51, 52, 58, 59, 61, 62, 68, 69, 75, 76, 78, 79, 85, 86, 92, 93, 95, and 96, are currently pending. Previously, claims 3-9, 12-16, 19, 22-26, 29-33, 36-40, 43, 46-50, 53-57, 60, 63-67, 70-74, 77, 80-84, 87-91, 94, and 97-101, were canceled without prejudice or disclaimer. Reconsideration and allowance of all the claims are respectfully requested in view of the following remarks.

Claim Rejections – 35 U.S.C. §103

Claims 1, 2, 10, 11, 17, 18, 20, 21, 27, 28, 34, 35, 41, 42, 44, 45, 51, 52, 58, 59, 61, 62, 68, 69, 75, 76, 78, 79, 85, 86, 92, 93, 95 and 96 are rejected under §103(a) as being unpatentable over US Publication 2002/0073735 to Hayashi et al (hereinafter Hayashi).

Applicants respectfully traverse this rejection for the following reasons.

Previously, Applicants argued that the independent claims 1-6 and 17-19 expressly include a recitation of Bi_2O_3 as an essential component. Applicants asserted that there is no teaching or suggestion in Hayashi that Bi_2O_3 should be used. Applicants made reference to the Examples and Tables 1-6 in Hayashi to confirms this observation.

However, the Examiner now points out that Hayashi does mention the use of Bi_2O_3 at paragraph [0049], where it is noted that the compound may be added in amounts of 0-6 molar%. The Examiner observes that this overlaps the claimed ranges, namely Bi_2O_3 is equal to or greater than 0.5 molar percent, but does not exceed 15 molar percent. Further, the Examiner admits that Hayashi fails to teach any examples or compositional ranges that permit anticipation, but argues that the ranges overlap sufficiently that the invention may be considered obvious.

In order to rebut the Examiner's alleged case of *prima facie* obviousness, Applicants submit herewith a Declaration Under 37 C.F.R. § 1.132 showing unexpected results from the addition of Bi_2O_3. More specifically, Applicants conducted additional experiments in order to overcome the prior art rejection over Hayashi (US2002/0073735), and details of the experiments are described in the attached Declaration Under 37 C.F.R. § 1.132.

In the experiments, Applicants selected Glass No. 22 described in Table 5 of Hayashi as a base glass because Glass No. 22 has relatively similar composition to the optical glass of the present invention other than that no Bi_2O_3 is comprised.

As described in the attached Declaration, addition of Bi_2O_3 yields unexpected results in that optical glass that exhibits high refractive index and high dispersion, as well as possesses excellent stability and is suitable for use in precision press molding property can be obtained.

In contrast, Hayashi selected WO_3, Nb_2O_5 and TiO_2 as an essential component imparting high refractive index to the glass (see claim 1, [0034], [0035], and [0037] of Hayashi). Hayashi merely describes Bi_2O_3 as one of optional components, and neither teaches nor suggests Bi_2O_3 is such an effective component as shown in the attached Declaration.

Therefore, Applicants believe that the optical glass according to the above pending claims possesses improved properties not expected by Hayashi, and thus could not be inferred by those skilled in the art from the teaching of Hayashi. Furthermore, other pending claims relate to a method of manufacturing a press molding preform, and optical element and a method of manufacturing an optical element in which the above claims relating to an optical glass is referred. Therefore, Applicants believe that the inventions according to these claims are also patentable because of the same reasons as mentioned above.

Double Patenting

The Examiner provisionally rejects claims 1, 2, 10, 11, 17, 18, 20, 21, 27, 28, 34, 35, 41, 42, 44, 45, 51, 52, 58, 59, 61, 62, 68, 69, 75, 76, 78, 79, 85, 86, 92, 93, 95 and 96 under the judicially created non-statutory ground of obviousness double patenting in view of claims 1-28 of copending Application 10/878,618.

In order to obviate this rejection, without commenting on the merits thereof, Applicants have submitter herewith a terminal disclaimer. As noted in *Quad Environmental Technologies*, the filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting and raises neither presumption nor estoppel on the merits of the rejection. It

is improper to convert this simple expedient of "obviation" into an admission or acquiescence or estoppel on the merits.[1] See also, MPEP §804.02.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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[1] *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ.2d 1392, 1394, 1395 (Fed. Cir. 1991).